

REMARKS

The drawings in this application stand rejected by the Examiner as being “hand drawn/pencil sketches” and thus “not acceptable for examination.” The Examiner has also rejected claims 1 through 13 under 35 U.S.C. §112, first paragraph, as having allegedly failed to comply with the enablement requirement.

Applicant has prepared, and submits with this paper, new drawings in ink that duplicate and replace the originally-submitted “hand drawn/pencil” drawings. Additionally, Applicant has amended claims 1, 6 and 9, to clarify the scope of the invention by explicitly stating what the claim term “BIN” stands for. The previous scope of the amended claims has not been narrowed as a result of Applicant’s amendments.

In view of these amendments, and the Applicants remarks as set forth below, Applicant respectfully requests that the Examiner reconsider his rejection of the drawings, and of claims 1 through 13.

I. The Drawings

Applicant has prepared, and submits with this paper, a set of drawings that duplicate, in ink, the originally submitted “hand drawn/pencil” drawings rejected by the Examiner. In view of these replacement drawings, Applicant respectfully requests that the Examiner’s rejection of the drawings in this case be withdrawn.

II. Rejection of Claims 1 through 13:

a. The Term “BIN”

The Examiner has rejected claims 1-13 as allegedly failing to comply with the enablement requirement of Section 112, first paragraph. In particular the Examiner objects to the claim term “BIN,” stating that “[t]he term ‘BIN’ appears to have different meanings throughout the Specification and the Claims . . . [and] requires further clarification.

As amended, the claims clarify that the term “BIN” stands for bank identification number. “BIN” is term that is commonly used by, and well-known to, those of ordinary skill in the art of developing and deploying financial transaction networks. A BIN is a portion of an account number that uniquely identifies the issuer or acquirer in a financial transaction network. Applicant respectfully submits that “BIN” is consistently used in its commonly used and well-

understood manner throughout the specification and claims, and that thus its meaning would not be at all ambiguous or unclear to one of ordinary skill in the art.

Additionally, the Examiner suggests that Applicant has redefined the term BIN to include both service provider identification numbers and pseudo account numbers. *See* Office Action at p. 3. Applicant, however, has not redefined BIN at all. One of ordinary skill in the art would readily recognize that a BIN functions as a service provider identification number. Moreover, Applicant does not use the terms BIN and pseudo account number interchangeably. Rather, Applicant clearly states that the pseudo account number may have, for example, as its BIN a special BIN that is reserved for pseudo account numbers. *See e.g.*, Specification at ¶ [0025].

In short, far from redefining the term “BIN,” Applicant has used that term consistently in a way that would be well-understood by one of ordinary skill in the art, and in a way that is fully compliant with the requirements of Section 112, first paragraph.

b. Support in Specification

The Examiner has asked Applicant to detail what portions of the specification support the limitations of each of the pending claims. In addition, the Examiner has asked that the Applicant offer further clarification and support for the terms “second account number,” “second authorization request,” and “second acquirer code.” Support for these terms can be found throughout the specification including, but not limited to, the portions of the specification indicated below.

Support for claim 1 may be found on at least p. 14, lns. 9-13; p. 15, lns. 4-5; and p. 16, ln. 22 through p. 18, ln. 17.

Support for claim 2 may be found on at least p. 18, lns. 9-17.

Support for claim 3 may be found on at least p. 11, ln. 19 through p. 12, ln. 20.

Support for claim 4 may be found on at least p. 15, lns. 5-10.

Support for claim 5 may be found on at least p. 11, ln. 19 through p. 12, ln. 11; p. 12, ln. 12 through p. 13, ln. 11; p. 13, lns. 12-20; p. 12, ln. 12 through p. 13, ln. 11; p. 14, lns. 1-13; p. 16, ln. 22 through p. 17, ln. 5; and p. 18, lns. 9-17.

Support for claim 6 may be found on at least p. 14, lns. 9-13; p. 15, lns. 2-8; and p. 16, ln. 22 through p. 17, ln. 5.

Support for claim 7 may be found on at least p. 17, lns. 1-5.

Support for claim 8 may be found on at least p. 18, lns. 9-17; and p. 12, ln. 17 through p. 14, ln. 13.

Support for claim 9 may be found on at least p. 7, lns. 3-8, 13-20; p. 8, lns. 16-20; p. 11, ln. 12 through p. 13, ln. 20; p. 15, lns. 2-8; p. 16, ln. 22 through p. 17, ln. 5; and p. 18, lns. 6-17.

Support for claim 10 may be found on at least p. 12, ln. 12 through p. 13, ln. 20.

Support for claim 11 may be found on at least p. 11, ln. 15 through p. 12, ln. 11.

Support for claim 12 may be found on at least p. 15, ln. 2 through p. 16, ln. 21.

Support for claim 13 may be found on at least p. 16, ln. 22 through p. 17, ln. 5; and p. 18, lns. 6-17.

Further clarification and support for the terms “second account number,” “second authorization request,” and “second acquirer code,” may be found in at least the above-cited portions of the specification.

Applicant respectfully submits that at least the above-cited portions of the specification support the pending claims in such a way as to enable one skilled in the art of the development and deployment of debit / credit card networks to make or use Applicant’s invention. The claims therefore meet the requirements of Section 112, first paragraph.

c. Alleged Use of Different Terms For the Same Entity

Examiner alleges that “[i]t appears the Applicant uses different terms for the same entity. i.e. user, acquirer, etc.” What is meant by this is unclear. Is the Examiner alleging that the terms “user” and “acquirer” are used by the Applicant in the specification and claims to refer to the same entity? Or is the Examiner alleging that Applicant is using different terms to refer to a “user” and an “acquirer?” In either event, the Examiner’s allegation fails to support a rejection under Section 112, first paragraph.

Assuming the former – that the Examiner is alleging that the terms “user” and “acquirer” are both used by Applicant to refer to the same entity – the Examiner’s allegation is simply

incorrect. Applicant consistently uses the term “user” to refer to a person that is linked to a specific account for purposes of conducting a financial transaction. *See* Specification, p. 7 at lns. 7-8. The term “acquirer” on the other hand, has nothing to do with a “user.” “Acquirer” is used by Applicant to refer to a processor that routes transaction data between the merchant and the service provider. Figs. 3, 4, and 5. In short, it is simply untrue that the Applicant uses the different terms “user” and “acquirer” to refer to the same entity.

Assuming the latter – that the Examiner is alleging that Applicant is using different terms to refer to a “user” or an “acquirer” – the Examiner’s allegation is unsupported. The Examiner has not provided any example of what different terms are being used by Applicant to refer to “acquirer” and “user.” Consequently, the Examiner has not met the initial burden of establishing a reasonable basis to question the enablement provided by Applicant for the claimed invention. *See In re Wright*, 999 F.2d 1557, 1562 (Fed. Cir. 1993).

In short, however one reads it, the Examiner’s allegation that “Applicant uses different terms for the same entity, *i.e.*, user, acquirer, etc.,” fails to support a rejection under Section 112, first paragraph, and that rejection by the Examiner should be withdrawn.

d. Alleged Changing of Definition of Issuer

Finally, Applicants respectfully disagree with the Examiner’s allegation that the definition of “issuer” changes throughout the specification and claims. Throughout the specification and claims, the term “issuer” is used to refer to the financial institution or other entity that issues a payment account number that a consumer may use to make a payment for goods and/or services. *See, e.g.*, Specification at p. 8, lns. 11-13. One such financial institution that issues a payment account number is a credit card company. The “issuer of said second number” refers to the “issuer” as described above. Thus, the definition does not change throughout the specification or claims; the “issuer” always corresponds to the financial institution or other entity that issues a payment account number to a consumer.


III. Conclusion

In view of the foregoing remarks, favorable consideration and allowance of claims 1-13 are respectfully solicited. In the event that the application is not deemed in condition for allowance, the examiner is invited to contact the undersigned in an effort to advance the prosecution of this application.

Respectfully submitted,

BAKER BOTTS L.L.P.

Dated: October 13, 2004



Robert C. Scheinfeld
Patent Office Reg. No. 31,300

BAKER BOTTS L.L.P.
30 Rockefeller Plaza
New York, NY 10112-4498
Attorney for Applicants
212-408-2500